

REMARKS

In response to the Office Action mailed February 16, 2005, Applicants respectfully request reconsideration.

Claims 1-10 were previously pending in this application. By this amendment, Applicants cancel claim 9 without prejudice or disclaimer, amends claims 1-8 and 10 solely for clarification, and adds claims 10-14. As a result, claims 1-8 and 10-14 are pending for examination, of which claims 1-8, 10, 11 and 14 are independent. No new matter has been added.

1. Priority Claim

Previously (January 20, 2004), Applicants added a priority claim to page 2 of the Specification. The Office Action asserts that this claim of priority is not sufficient because it does not specify the relationship between the present application and the previously-filed applications specified in the priority chain.

In response, Applicants have amended the priority claim to recite specific relationships between the present application and any applications to which priority is claimed. Further, Applicants have made changes to the priority claim that correct inadvertent errors in the priority claim added on January 20, 2004. Applicants also have added a claim for priority as a continuation-in-part (CIP) application to U.S. Patent Application Serial No. 09/024,278.

The present application enjoys a filing date of October 16, 2000, which is earlier than November 29, 2000. Accordingly, per 37 C.F.R. §1.78(2)(ii)(B), Applicants have the right to make a priority claim at any time during the pendency of the application. Accordingly, Applicants respectfully request that the changes and additions to the priority claim set forth above be entered in the application.

2. Claims 2 and 3 as Amended Overcome the Claim Objections

In response to the objections to claims 2 and 3, these claims have been amended as shown above by adding the word "and" and the word "a", respectfully to claims 2 and 3. Accordingly, Applicants respectfully request that the objections to claims 2 and 3 be withdrawn.

3. Claims 1-10 Satisfy the Requirements of §112, 2nd Paragraph

Claims 1-10 stand rejected under 35 U.S.C. §112, 2nd paragraph for lacking transitional phases between the preamble and the body. In response, Applicants have amended each of claims 1-10 by adding the transitional phrase “comprising” between the preamble and the body. Accordingly, Applicants respectfully request that the rejection of claims 1-10 under §112, 2nd paragraph, be withdrawn.

4. Claims 1-10 Recites Statutory Subject Matter

Claims 1-10 stand rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

The Office Action contends that the language of claims 1-10 raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which results in a practical application producing a concrete, useful, and tangible results. The Office Action then provides examples of how some of the limitations in the claims could be performed by humans, without the assistance of a computer. Firstly, the fact that an invention can be performed without the use of a computer is not a legally-recognized basis for rejection under Section 101, as was recently confirmed by the Board of Patent Appeal and Interferences in *Ex Parte Lundgren* and the PTO in its *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*. Further, the Office Action’s interpretation of the claims—that all of the steps could be performed by a human—is unreasonable in the context of the specification and in light of the knowledge of one of ordinary skill in the art. However, to expedite the prosecution of this application, and without acquiescing to the §101 rejection, Applicants have amended claims 1-10 as shown above so that each claim recites “communicating *electronically*”.

In view of the foregoing, Applicants respectfully request that the rejection of claims 1-10 under 35 U.S.C. §101 be withdrawn.

5. Claim Support in the ‘354 Application

As noted above, the priority claim of the present application has been amended to recite priority through U.S. Patent Application Serial No. 09/024,278 to U.S. Provisional Patent

Application; Serial No. 60/037,354 (the '354 Application), which has a filing date of February 21, 1997. The '354 application provides support for at least claims 1, 2, 4 and 10-14 of the present application; specifically on page 5, line 10-page 49, line 23 (e.g., the use of target profiles described throughout), in particular for "location information" and "mobile communicant" on: page 7, lines 19-21; page 19; lines 18-20; page 27, lines 4-6; page 47, lines 4-7, 12-14, 17-20 and 25-27; and page 48, lines 22-31.

6. Claim 1 Patentably Distinguish Over Titmuss

Claim 1 stands rejected under 35 U.S.C. §102(e) as purportedly being anticipated by U.S. Patent No. 6,397,040 (Titmuss). Applicants respectfully traverse this rejection.

As noted above, claim 1 finds support in the '354 Application, which has a filing date of February 21, 1997. This filing date is before the §102(e) effective filing date of Titmuss, which is the §371 date of August 25, 1998. Accordingly, Titmuss was not filed in the U.S. before the invention by the Applicants, as required by §102(e) and cannot anticipate the claimed subject matter.

In view of the foregoing, claim 1 patentably distinguishes over Titmuss, and Applicants respectfully request that the rejection of claim 1 be withdrawn.

7. Claim 1 Patentably Distinguishes Over Bar

Claim 1 stands rejected under 35 U.S.C. §102(e) as purportedly being unpatentable over Bar. Applicants respectfully traverse this rejection.

As noted above, claim 1 is supported in the '354 Application, which has a filing date of February 21, 1997, which is before the October 10, 1997 filing date of Bar. Accordingly, Bar is not prior art to claim 1 under §102(e).

Additionally, Applicants note that Bar is a continuation-in-part application of Application No. 08/780,565, filed on January 7, 1997, now U.S. Patent No. 6,026,304. Claim 1 also patentably distinguishes over the '304 patent, which does not include the disclosure on which the Office Action is relying in asserting Bar. Namely, the '304 patent does not disclose or suggest "information or advertisements can be provided to the user based on a present location and/or the user's personal profile" (Office Action, page 6, Section 7).

In view of the foregoing, Applicants respectfully request that the rejection of claim 1 under §102(e) as being unpatentable over Bar be withdrawn.

8. Claim 2 Patentably Distinguishes Over Bar

Claim 2 stands rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Bar. Applicants respectfully traverse this rejection.

As noted above, claim 2 is supported in the '354 Application, which has a filing date of February 21, 1997, which is before the October 10, 1997 filing date of Bar. Accordingly, Bar is not prior art to claim 2.

In view of the foregoing, Applicants respectfully request that the rejection of claim 2 under §103(a) as being unpatentable over Bar be withdrawn.

Further, claim 2 patentably distinguishes over the '304 patent for reasons that should be clear of the discussion of the '304 patent above.

9. Claim 3 Patentably Distinguishes Over Bar

Claim 3 stands rejected under 35 U.S.C. §103 as being unpatentable over Bar. Applicants respectfully traverse this rejection.

The Office Action concedes (page 9, first full paragraph) that Bar does not disclose maintaining a travel route database for at least the present locations. However, the Office Action continues:

"Nonetheless, given this ability to maintain a location database, a person having ordinary skill in the art would have readily recognized the capability of additionally maintaining the user's travel route history in order to maintain a log of user's movements. Given this knowledge, it would have been obvious to allow the system of Bar to use the travel route history to affect delivery of the digital content, in order to better tailor the user information to fit the user's needs and desires."

Applicants respectfully disagree. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaack*, 947 F.2d 488 (M.P.E.P. §2143; The Manual of Patent Examining Procedure, original 8th Ed., August 2001, latest revision August 2005; page 2100-

135, 1st col.). The Office Action has failed to point to any motivation or suggestion in Bar itself or in the knowledge generally available to one of ordinary skill in the art for modifying the teachings of Bar to utilize a user's travel route history. As conceded by the Office Action, Bar is silent in this regard, and the Examiner has provided no support for the proposition that such knowledge would have been generally available to one of ordinary skill in the art at the time of Applicants' invention. The only motivation for making such a modification comes from Applicants' specification, and hindsight is an improper basis for establishing the requisite motivation under §103(a).

In view of the foregoing, the Office Action has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the rejection of claim 3 under §103(a) be withdrawn.

10. Claim 4 Patentably Distinguishes Over Bar

Claim 4 stands rejected under §102(e) as purportedly being anticipated by Bar. However, as noted above, claim 4 finds support in the '354 Application, which has a priority date of February 21, 1997 that predates the October 10, 1997 filing date of Bar. In view of the foregoing, Bar is not prior art to claim 4 under §102(e).

Accordingly, Applicants respectfully request that the rejection of claim 4 under §102(e) be withdrawn.

11. Claim 5 Patentably Distinguishes Over Bar

Claim 5 stands rejected under §102(e) as purportedly being anticipated by Bar. Applicants respectfully traverse this rejection.

Claim 5 patentably distinguishes over Bar because Bar does not teach or suggest a method of communicating electronically, comprising, *inter alia*, generating a current trip vector based upon a quiet location information, as recited in claim 5. It is not clear from the Office Action (page 7, lines 1-9) where in Bar the Office finds the teaching of "generating a current trip vector based upon acquired location information". The Office Action appears to contend that this is disclosed by Bar's alleged teaching that "information or advertisements can be provided to the user based on a present location and/or the user's personal profile," (col. 5, lines 42-55, col.

6, lines 5-12 and 16-24). However, nowhere in these cited passages is there any mention or suggestion of generating a current trip vector. Further, providing information or advertisements based on a present location and/or user profile is very different from generating a current trip vector. A vector can only be generated from two or more successive locations. One location – the current location – is just not enough. Bar thus fails to teach, suggest or make obvious the claimed subject matter

In view of the foregoing, claim 5 patentably distinguishes over Bar. Accordingly, Applicants respectfully request that the rejection of claim 5 under §102(e) be withdrawn.

12. Claim 6 Patentably Distinguishes Over the Combination of Bar and Burns

Claim 6 stands rejected under 35 U.S.C. §103(a) as purportedly being obvious over Bar in view of U.S. Patent No. 5,991,306 (Burns). Applicants respectfully traverse this rejection.

The Office Action asserts that it would be obvious to allow the system of Bar to predict a future location of a user in order to better tailor the user information to fit the user's expected needs. As noted above in Section 9, to establish *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. The Office Action has failed to point to any motivation or suggestion in Bar itself or in the knowledge generally available to one of ordinary skill in the art for modifying the teachings of Bar to utilize conditional probability to identify a plurality of potential feature locations for said particular mobile communicant. As conceded by the Office Action, Bar is silent in this regard, and the Examiner has provided no support for the proposition that such knowledge would have been generally available to one of ordinary skill in the art at the time of Applicants' invention. The only motivation for making such a modification comes from Applicants' specification, and such hindsight is an improper basis for establishing the requisite motivation under §103(a).

In view of the foregoing, the Office Action has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the rejection of claim 6 under §103(a) as being unpatentable over Bar in view of Burns be withdrawn.

13. Claim 7 Patentably Distinguishes Over Bar in View of Merriman

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Bar in view of U.S. Patent No. 5,948,061 (Merriman). Applicants respectfully traverse this rejection.

The Office Action concedes that Bar does not disclose or suggest utilizing autonomous user-side agents to negotiate terms and conditions for the receipt of and in advertisement, but contends that it is well known to negotiate advertisements based on autonomous user-side agents (i.e., cookies), as evidenced by Merriman. However, a cookie is not an agent and is not autonomous, but rather is passive data that must be acted on by another process. Thus, Merriman does not provide the motivation to modify the teachings of Bar as suggested by the Office Action. Accordingly, the Office Action has failed to establish a *prima facie* case of obviousness.

In view of the foregoing, claim 7 patentably distinguishes over Bar in view of Merriman. Accordingly, Applicants respectfully request that the rejection of claim 7 under §103(a) be withdrawn.

14. Claim 8 Patentably Distinguishes Over Bar in View of Common Knowledge at the Time of the Invention

Claim 8 stands rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Bar in view of what was commonly known in the art at the time of the invention. Applicants respectfully traverse this rejection.

Claim 8 has been amended as shown above to clarify that the method of communicating electronically comprises, *inter alia*: Acquiring sensor data from the vehicle associated with said particular mobile communicant, **at a location remote from a vehicle**. The Office Action takes official notice that “it is well known to acquire sensor data from a vehicle associated with a particular mobile communicant (i.e. it is well known for a driver associated with a vehicle to read acquired sensor data from the vehicle, such as speed, oil pressure, engine heat, gas tank level, miles traveled, etc.)” However, as noted above, claim 8 has been amended to recite that the sensor data is acquired at a location remote from the vehicle. Accordingly, the Examiner’s official notice is rendered moot. Accordingly, as there is no motivation provided in Bar, or the general knowledge available to those of skilled in that art at the time of the invention to modify

991537.1

Bar to acquire sensor data from a vehicle associated with said particular mobile communicant, at a location remote from the vehicle, claim 8 is not rendered obvious by Bar.

In view of the foregoing, claim 8 patentably distinguishes over Bar in view of what was commonly known in the art at the time of the invention. Accordingly, Applicants respectfully request that the rejection of Bar under §103(a) be withdrawn.

15. Claim 10 Patentably Distinguishes Over Bar

Claim 10 stands rejected under §102(e) as purportedly being anticipated by Bar. However, as noted above, claim 10 finds support in the '354 Application, which has a priority date of February 21, 1997 that predates the October 10, 1007 filing date of Bar.

In view of the foregoing, Bar is not prior art to claim 10 under §102(e). Accordingly, Applicants respectfully request that the rejection of claim 10 under §102(e) be withdrawn.

16. New claims 11-14 Patentably Distinguish Over the Art of Record

As noted above, claims 11-14 are supported by the '354 Application, and as such are patentable over the art of record for reasons that should be clear from the foregoing discussion.

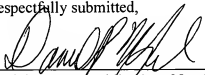
CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

By:


Daniel P. McLoughlin, Reg. No. 46,066
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
Telephone: (617) 646-8000

Docket No.: P0813.70015US01
Date: February 16, 2006